

REMARKS

This Amendment is submitted in response to the Office Action dated August 16, 2002. In the Office Action, the Patent Office rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,697,648 to *Petkovsek*. Further, the Patent Office rejected Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,664,725 to *Walz* in view of U.S. Patent No. 6,001,209 to *Popat et al.*

By the Present Amendment, Applicant amended Claims 1, 13 and 16. Applicant submits that the amendments to the claims overcome the rejections as made by the Patent Office and places the application in condition for allowance.

With respect to the rejection of Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek*, Applicant submits that this rejection has been overcome in view of amended Claims 1 and 13 and for the reasons that follow.

More specifically, in the Office Action, the Patent Office alleged:

Petkovsek discloses in Figures 1, 2 and 6, a mailing assembly comprising a backing sheet, first and second mailing forms removably attached to the backing sheet by an adhesive and separable by a tear line wherein the forms include a first return postcard integrally formed with a designator section (24A) indicative of a special service (Col. 4, lines 29-31), having a machine readable code.

Independent Claim 1 of Applicant's invention requires a special service mailing assembly with a backing sheet and a first mailing form removably attached to the backing sheet by an

adhesive. The first mailing form has a first return postcard integrally formed with a first designator section contained within first exterior sides that define the first return postcard. In addition, the first designator section has a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services.

Petkovsek does not teach or suggest this feature of Applicant's invention. In fact, *Petkovsek* merely teaches the use of a color to assist a machine in reading a code printed on the form. Applicant asserts that one of ordinary skill in the art would not have been motivated to modify *Petkovsek* to arrive at Applicant's invention. Therefore, Applicant asserts that amended Claim 1 overcomes the rejection of the Patent Office under 35 U.S.C. §103(a) as being obvious in view of *Petkovsek*.

Independent Claim 13 requires a method for preparing a mailpiece for delivery by a special service. The method has the step of providing a first return postcard having exterior sides and a first special designation section completely within exterior sides of the first return postcard. Claim 13 has been amended to further define the first special designation section as having an area for receiving instructions regarding the delivery of the mailpiece by the special service.

Petkovsek does not teach or suggest this feature of Applicant's method. *Petkovsek* merely teaches providing a

designation section with the first return postcard. Applicant asserts that one of ordinary skill in the art would not have been motivated to modify *Petkovsek* to arrive at Applicant's method. Accordingly, Applicant asserts that Claim 13, as amended, overcomes the rejection of the Patent Office under 35 U.S.C. §103(a) as being obvious in view of *Petkovsek*.

It is submitted that the question under 35 U.S.C. §103(a) is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's label and method, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Petkovsek* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Petkovsek* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Accordingly, the rejection of Claims 1-15 under 35 U.S.C. §103, in view of *Petkovsek*, is improper and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 16-20 as being unpatentable over *Walz* in view of *Popat et al.*, Applicant respectfully submits that, in view of amended Claim 16, and for the reasons that follow this rejection is also improper.

In the Office Action, the Patent Office alleged:

Walz discloses in Fig. 1, 4 and 5, an assembly comprising a first form having a first postcard (70), a first anchor portion removably attached to the postcard via a tear line, wherein the first anchor has adhesive on the backside of the anchor, a first backing strip received over the adhesive on the anchor portion's backside, an integrally formed designator section indicative of special services, an area contained within the postcard printed with machine readable code, and a second form removably attached to the first form by a tear line.

Still further, the Patent Office alleged:

Popat et al. discloses in Figure 10, an assembly comprising a first form and a second form, wherein a tear line is arranged to separate the first form from the second form. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Walz's* assembly to include a multiple

form assembly connected by a tear line as taught by *Popat et al.* for the purpose of printing multiple areas of a sheet without disposing of extra, unused paper area and for providing convenience for anyone using an advanced printer.

However, amended Claim 16 requires a mailing assembly for preparing a mailpiece for delivery by a special service. The mailing assembly has a first return postcard. In addition, amended Claim 16 requires a first designator section indicative of a special service contained within exterior sides of the first return postcard wherein the special service identifies one of registered mail, certified mail, COD, insured mail and return receipt for merchandise.

Popat et al. merely teach a method for preparing and printing adhesively-backed notes.

Walz does not teach or suggest a return postcard having a non-adhesive backside. Nor does *Walz* teach a first return postcard containing a first designator section indicative of a special service contained within exterior sides of the first return postcard wherein the special service identifies one of registered mail, certified mail, COD, insured mail and return receipt for merchandise.

Applicant asserts that neither *Walz* nor *Popat et al.*, taken singly or in combination, teach or suggest a mailing assembly for preparing a mailpiece for delivery by a special service with a first return postcard containing a first designator section

indicative of registered, certified or insured mail, with a return receipt. Therefore, the rejection under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Further, it is submitted that the question under 35 U.S.C. §103(a) is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's label and method, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Walz* and *Popat et al.* in mind, as enumerated above, no reason or suggestion in the

evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Accordingly, the rejection of Claims 16-20 under 35 U.S.C. §103 is improper and should be withdrawn. Notice to that effect is requested.

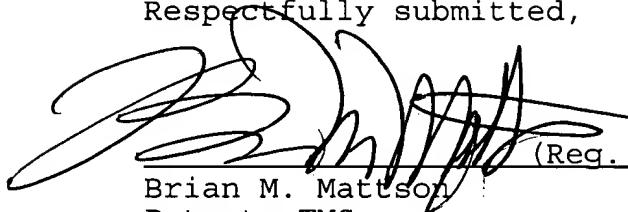
Claims 2-12 depend from Claim 1; Claims 14 and 15 depend from Claim 13; and Claims 17-20 depend from Claim 16. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims since each sets forth additional structural elements and steps of Applicant's novel assembly and method, respectively.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment. Therefore, entry of this Amendment is proper and should be effected.

If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable

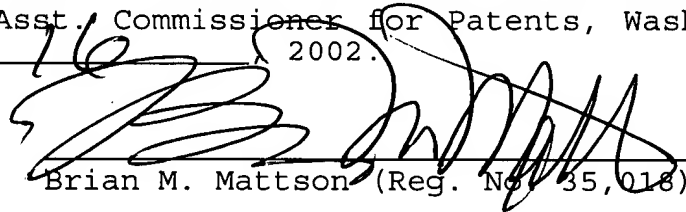
and to pass the application to issue.

Respectfully submitted,


(Reg. No. 35,018)
Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, Illinois 60647
Telephone: (773) 772-6009
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this **Amendment After Final** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231 on October 16 2002.


Brian M. Mattson (Reg. No. 35,018)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend Claim 1 as follows:

1. A special service mailing assembly comprising:

a backing sheet;

a first mailing form removably attached to the backing sheet by an adhesive wherein the first mailing form includes a first return postcard and a first designator section [indicative of a special service] contained within first exterior sides that define the first return postcard wherein the first designator section has a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services; and

a second mailing form removably attached to the first mailing form wherein the second mailing form is removably attached to the backing sheet by the adhesive and further wherein the second mailing form includes a second return postcard and a second designator section indicative of the special service contained within second exterior sides that define the second return postcard.

Please amend Claim 13 as follows:

13. A method for preparing a mailpiece for delivery of the mailpiece by a special service, the method comprising the steps of:

providing a backing sheet;

providing a first mailing form including a first return postcard removably attached to the backing sheet wherein the first

return postcard is integrally formed with a first special service designation section wherein the designation section has an area for receiving instructions regarding the delivery of the mailpiece by the special service and further wherein the first special designation section is completely within exterior sides that define the first postcard;

providing an area within the return postcard wherein variable information is printed;

providing a second mailing form including a second return postcard removably attached to the backing sheet wherein the second return postcard is integrally formed with a second special designation section wherein the second special designation section is completely within exterior sides that define the second postcard;

printing information relating to the special service delivery of the mailpiece on the area within the return postcard;

removing the first mailing form from the backing sheet; and

attaching the first mailing form to the mailpiece to effect delivery of the mailpiece by the special service.

Please amend Claim 16 as follows:

16. A mailing assembly for preparing a mailpiece for delivery by a special service, the assembly comprising:

a first mailing form having a first return postcard and a first anchor portion removably attached to the first return postcard wherein the first anchor portion has an adhesive on a

backside of the first anchor portion[,] and further wherein the first return postcard [having] has no adhesive;

a first backing strip received over the adhesive on the backside of the first anchor portion;

a second mailing form having a second return postcard and a second anchor portion removably attached to the second return postcard wherein the second anchor portion has the adhesive on a backside of the second anchor portion[,] and further wherein the second return postcard [having] has no adhesive;

a second backing strip received over the adhesive on the backside of the second anchor portion; and

a first designator section indicative of a special service contained within exterior sides of the first return postcard wherein the special service identifies one of registered mail, certified mail, COD, insured mail and return receipt for merchandise.